Remarks/Arguments

The foregoing amendments to the claims are of formal nature, and do not add new matter. Claims 119-126, 129-131, 135-142 are now pending in this application. Claims 119-128 have been amended for clarity to particularly claim what the applicants consider is their invention and with the recitation "wherein said nucleic acid is amplified in lung and colon tumors," support for which is found in Example 170 of the instant specification. The rejections to the presently pending claims are respectfully traversed.

Information Disclosure Statement

Applicants had submitted an IDS compliant with 37 C.F.R. § 1.98(a)(1) on June 14, 2004. Consideration of this Information Disclosure Statement is respectfully requested.

Claim Rejections – 35 USC § 112, First paragraph- Enablement

Claims 119-126 and 135-142 remain rejected under 35 U.S.C. §112, first paragraph allegedly because the specification does not reasonably provide enablement for any variants.

The Examiner acknowledges that the specification provides enabling disclosure for SEQ ID NO: 206 but asserts that variants or fragments of such sequences are not enabled by the gene amplification assay.

Without acquiescing to the propriety of this rejection, Applicants have canceled claims 119-123 without prejudice or disclaimer, thereby rendering this rejection moot to these claims. As explained below in the arguments for written description, Applicants submit that the genus of nucleic acids that code for the polypeptide of SEQ ID NO: 207 and which further possess the functional property of being "amplified in a lung or colon tumors" would encompass a genus with at least 95% identity to the sequence of SEQ ID NO: 206, and should be patentable. Thus, Claim 124 and its dependent claims should be patentable.

Thus, Applicants believe that this rejection under 35 U.S.C. §112, first paragraph should be withdrawn.

Claim Rejections – 35 USC § 112, first paragraph- written description

Claims 119-126 and 135-142 are rejected under 35 U.S.C. §112, first paragraph for failing to comply with the written description requirement. The Examiner contends that "the claims contain subject matter not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention." Applicants respectfully traverse this rejection to the pending claims.

As mentioned above, Applicants have canceled claims 119-123, without prejudice or disclaimer, hence this rejection is moot with respect to these claims. Further, based on the Written Description guidelines issued by the U.S. Patent Office, especially in Example 14, Applicants submit that the instant specification evidences the actual reduction to practice of a full-length native human PRO polypeptide (SEQ ID NO: 207), with or without its signal sequence. In addition, the specification provides detailed description about the cloning of variants of the polypeptide of SEQ ID NO: 207 (see, e.g. pages 154-155 and 196-201), and describes the gene amplification assay for testing nucleic acids in a PCR based assay. Thus, Applicants indicate that the genus of nucleic acids that code for the polypeptide of SEQ ID NO: 207 and which also possess the functional property that it is "amplified in a lung or colon tumors" would encompass a small genus that would have at least 95% identity to the sequence of SEQ ID NO: 206 that should be patentable. For example, see Example 14 of the written description guidelines.

The Examiner further asserts that "the state of the art is such that the skilled artisan would not make variants of a specific probe to make a different probe for the same target, knowing that making a probe that is less than 100% identical to its target would reduce probe specificity". Applicants submit that the purpose in making probes slightly different from SEQ ID NO: 206 is to probe for the amplification of target genes with slight variations that code for the polypeptide of SEQ ID NO: 207. Based on the disclosure of the exact sequence of SEQ ID NO: 207, and the advanced knowledge in the art of DNA recombination technology, one of skill in the art would know how to make the claimed variants and would further recognize that the Applicants were in possession of the members of the genus having the necessary common attribute of "being amplified in lung or colon tumors" as of the effective filing date of the present application.

Accordingly, the Examiner is respectfully requested to reconsider and withdraw the present rejection.

Claim Objections

Claims 129-131 are objected to as being dependent upon a rejected base claim.

Based on the current claim amendments and discussions above, Applicants believe that claim 124 upon which claims 129-131 depend is allowable. Hence this objection should be withdrawn.

The present application is believed to be in *prima facie* condition for allowance, and an early action to that effect is respectfully solicited.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 08-1641 (Attorney Docket No.: 39780-2730P1C54). Please direct any calls in connection with this application to the undersigned at the number provided below.

Respectfully submitted,

Date: November 2, 2004

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